

REMARKS

This application has been reviewed in light of the Office Action of July 1, 2005. Claims 1-9 are pending in this application. Claims 1-4 and 7-9 are rejected. Claims 5 and 6 are objected to. In response, claims 1, 3, 5, 6, and 9 are amended. Claims 2, 4, 7-8 are canceled.

With regard to the Examiner's rejections under 35 U.S.C. 112, Applicant has amended the appurtenant claims to eliminate any indefiniteness associated with the use of "substantially" or "the lower end." According, Applicant respectfully requests withdrawal of this rejection.

With regard to claim 1, the Examiner rejects claim 1 as being unpatentable over DiMatteo's '942 patent stating that DiMatteo teaches the protective cup having a convex outer surface, and a concave inner surface with sufficient volume to enclose a wearer's male genitals. As such, the Examiner concludes that the first portion and the second portion would have been obvious to one of ordinary skill in the art. The DiMatteo reference exemplifies, however, the type of problem Applicant solves with his invention. With DiMatteo, the wearer's scrotum is left essentially unsecured within the cup, allowing for the testicles to jar into each other causing discomfort and perhaps even injury. In response to the Examiner's rejection of claim 1, Applicant has amended Claim 1 to clarify that the second portion is conformed to the scrotum to minimize jarring of the testicles. Indeed, the Dimatteo '942 patent teaches away from this novel aspect of Applicant's protective cup device which minimizes jarring of the testicles.

The following principle of law applies to all rejections under 35 USC 103: MPEP 2143.03 provides "To establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." [Emphasis added] That is, to have any expectation of rejecting the claims over a single reference or a combination of references, each limitation must be taught somewhere in the applied prior art. If limitations are not found in any of the applied prior art, the rejection cannot stand. In this case, the applied prior art reference clearly does not teach some of the limitations of the claim, e.g., a second portion conformed to minimize jarring.

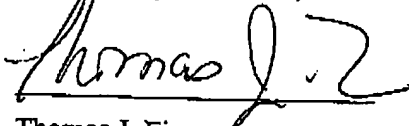
With regard to claim 3, claim 3 includes all limitations from claim 1. Because claim 1 is allowable, claim 3, as amended to overcome the indefiniteness rejection should be allowed as well.

The Applicant appreciates the Examiner's recognition of the novelty (and therefore allowability) of claims 5 and 6 if re-written to include the limitations of claim 1. Claim 5 has been amended accordingly and re-written in independent format to include the limitations of claim 1. Since claim 6 depends from claim 5, amending claim 6 is not necessary.

Applicant respectfully traverses the Examiners rejection of claim 9 and assertion that the DiMatteo patent teaches vis a' vis the doctrine of inherency that the penis is held in a vertical position and the testicles are held in a horizontal position. The prior art does not teach this. To the contrary, DiMatteo teaches a cup which allows the penis and testicles to all bunch up in one large cup-shaped compartment. Nowhere in DiMatteo does it teach or suggest that the cup positions the penis in vertical position while necessarily holding the testicles horizontally. Applicant takes exception to the conclusion that the DiMatteo inherently teaches this. The Examiner states that the testicles are inherently in a horizontal position. Applicant disagrees with the Examiner's finding that testicles inherently fall in a horizontal position. Indeed, it has been Applicant's experience through playing professional ball and using traditional athletic cups that testicles sometimes don't fall in a horizontal manner, but rather are bunched up against the penis and held in various positions. Applicant's invention solves this problem found in traditional devices, such as those disclosed and taught by DiMatteo.

In light of the foregoing amendment, it is believed that the currently pending claims, i.e., 1, 3, 5, 6, and 9, are allowable over the cited art. Claims 2, 4, 7-8 have been cancelled. Applicant respectfully requests that this application be allowed to proceed to issue.

Respectfully submitted,



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